



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,038	07/15/2003	Justin Shimck	6126US	7511
30173	7590	06/24/2008		
GENERAL MILLS, INC.				
P.O. BOX 1113				
MINNEAPOLIS, MN 55440				
EXAMINER				
MAHAFFEY, KELLY J				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
06/24/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/620,038

**Applicant(s)**

SHIMEK ET AL.

**Examiner**

Kelly Mahafkey

**Art Unit**

1794

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 2/27/08 & 4/14/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3-27, 29-39 and 81 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-27, 29-39 and 81 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Amendments made 2/27/08 have been entered.

Claims 1, 3-27, 29-39, and 81 remain pending.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 14, 2008 has been entered.

### ***Claim Rejections - 35 USC § 112***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 30 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 30 recites, "the food product of claim 29", however, claim 29 refers to claim 20, and there are two "products" recited in claim 20, both a "dried soft aerated food product" and a "composite food product". Thus it is unclear as to which "product" the limitations of claim 30 refer.

Claim 31 recites, "the food product of claim 30", however, claim 30 refers to claim 29, claim 29 refers to claim 20, and there are two "products" recited in claim 20, both a "dried soft aerated food product" and a "composite food product". Thus it is unclear as to which "product" the limitations of claim 30 refer.

### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3-9, 14, 15, 32, 38, and 81 are rejected under 35 U.S.C. 102(e) as anticipated by Roy et al (US 2004/0109933). The references and rejection are incorporated herein and as cited in the office action mailed January 14, 2008.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 10-13, 19, 20, 22, 24, 27, 29-31, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roy (US 2004/0109933), in view of Zietlow (US 6309686 B1). The references and rejection are incorporated herein and as cited in the office action mailed January 14, 2008.

Claims 16-18, 21, 23, 25, 26, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roy (US 2004/0109933), in view of Zietlow (US 6207216 B1). The references and rejection are incorporated herein and as cited in the office action mailed January 14, 2008.

Claims 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roy (US 2004/0109933), in view of Zietlow (US 6207216 B1), further in view of Iggoe (Dictionary of Food Ingredients, 4<sup>th</sup> Edition). The references and rejection are incorporated herein and as cited in the office action mailed January 14, 2008.

Claims 37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roy (US 2004/0109933), in view of Zietlow (US 6207216 B1) and Iggoe (Dictionary of Food Ingredients, 4<sup>th</sup> Edition), further in view of Gajewski (US 4251561). The references and rejection are incorporated herein and as cited in the office action mailed January 14, 2008.

### ***Response to Arguments***

Applicant's arguments filed February 27, 2008 and April 14, 2008, regarding the 112 rejections, have been fully considered but they are not persuasive.

Claim 29 previously depended on claim 22, which depended on claim 20; claim 29 has been amended to depend on claim 20. Applicant argues, Remarks Page 9, that

the 112 rejection should be withdrawn based upon the submitted amendments, however the amendment does not resolve the 112 issue. The 112 rejections of claims 30 and 31 remains as the recited claims would remain unclear. Claim 30 depends on claim 29, which depends on claim 20. Claim 31 depends on claim 30 which depends on claim 29, which depends on claim 20. Claims 30 and 31 refer to "*the food product*" of the preceeding claims, including claim 20. Claim 20 recites, "wherein *the dried soft aerated food product* is in the form of a phase or portion of a *composite food product*." Thus, as previously stated, it is unclear as to if the "food product" of claims 30 and 31 is referring to the "dried soft aerated food product" or to the "composite food product", both recited in claim 20.

Applicant's arguments filed February 27, 2008 and April 14, 2008, regarding the prior art rejections, have been fully considered but they are not persuasive.

Applicant argues that the references of record, specifically Roy does not teach of a marbit with the same glass transition temperature and spring back factor as instantly claimed. Applicant's argument is not convincing as Roy teaches of a similar confection with the instantly claimed softening agent within the instantly claimed range, it would be expected that Roy inherently teaches of a product that has a glass transition temperature and spring back factor as instantly claimed. Applicant is reminded that where the claimed and prior art products are substantially identical in structure or composition, a prima facie case of either anticipation or obviousness has been established. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." In re Spada, 911F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Applicant has chosen to use an equation with parameters and/or calculations that cannot be measured by the Office, for the purpose of prior art comparison, because the office is not equipped to manufacture prior art products and compare them for patentability. Therefore, as a prima facie case of obviousness has been properly established, the

Art Unit: 1794

burden is shifted to the applicant to show that the prior art product is different. Furthermore, as stated in the advisory action, applicant points out that the marbit composition as stated in the office action mailed April 24, 2007, page 6 is not supported by the teachings of Roy. Examiner has noted that a typo was made in the office action, however notes that the teachings of Roy still read upon the claimed ingredient percentages, and thus anticipate the claimed invention as stated above and in the previous office actions. In Example 1, Roy teaches a final product which comprises 0.1% water, 89.22% of a sucrose solution, and 5.7% of a gelatin solution. The sucrose solution consists of 65.72% sucrose, 12.38% corn syrup, 10.29% dextrose, and 11.61% water. The gelatin solution consists of 33.33% gelatin and 66.67% water. Thus the final product as taught by Roy in Example 1 comprises 0.1% water, 89.22% of a sucrose solution (or about 9% dextrose, about 10% corn syrup, about 59% sucrose, and about 10% water), and 5.7% of a gelatin solution (or about 4% water and 2% gelatin). The final product as taught by Roy in Example 1 contains about 14% water (10% from the sucrose solution and 4% from the gelatin solution) and thus about 86% dry ingredients. Thus on a dry weight basis, the final composition of Example 1, as taught by Roy contains about 2% gelatin and about 90% saccharide components or 11% dextrose, about 11% corn syrup, about 68% sucrose. Applicant argues that Roy does not teach of about 9% dextrose or 9% glycerin, i.e. a softener, as stated in the previous office action. As stated above, a typo was made in the office action and Roy does not teach of 9% dextrose in the composition of Example 1; Roy teaches of 11% dextrose in the marbit composition. Roy also teaches, paragraph 0010, that glycerin alone can be substituted for dextrose alone, thus Roy teaches that about 11% glycerin, i.e. a softener can be included in the marbit composition.

In response to applicant's argument that Zietlow teaches away from the invention by teaching a crisp marshmallow, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*,

642 F.2d 413, 208 USPQ 871 (CCPA 1981). Thus, applicant's argument is not convincing.

Applicant's affidavits and arguments concerning (Remarks pages 7 and 9) the affidavits filed February 27, 2008 and April 14, 2008 have been fully considered but they are not persuasive.

Applicant's arguments and affidavits state that it has been established that there was a reduction to practice of the present invention prior to the prior art date of October 31, 2003 in Roy et al, thus removing Roy et al. as prior art. Applicant's affidavit and arguments are not convincing as the statements made documenting the dates of the conception of the invention and the reduction to practice are not supported by any evidence. The Kamper affidavit refers to product samples and consumer tests, but provides no documentation or record of this (page 1 paragraph 2). The Geoffrion affidavit refers to a product presentation and consumer tests, but provides no documentation or record of this (page 1 paragraph 2). There is no evidence provided to determine if the instantly claimed invention was in fact conceived and reduced to practice prior to the prior art date of October 31, 2003. Thus, as stated above, applicant's affidavits are not convincing as there is no evidence to show conception and reduction to practice of the instantly claimed invention prior to the prior art date of Roy.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly Mahafkey whose telephone number is (571) 272-2739. The examiner can normally be reached on Monday through Friday 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1794

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lien Tran/  
Primary Examiner  
Art Unit 1794

/Kelly Mahafkey/  
Examiner  
Art Unit 1794